Decision for dispute CAC-UDRP-106872

Case number	CAC-UDRP-106872
Time of filing	2024-09-18 11:56:52
Domain names	liquidaudio.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Liquid Audio Inc.

Complainant representative

Organization	Liquid Audio Inc.

Respondent

Name	Mr. Stefan Todorovski

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant owns the US trademark registration No. 7445609 "LIQUID AUDIO", filed in 2022 and registered on July 16, 2024 (hereinafter referred to as the "Trademark").

The Respondent did not assert any trademark rights but priority registration rights of the disputed domain name.

FACTUAL BACKGROUND

The Complainant is Liquid Audio Inc., a California Corporation with its principal place of business in New Jersey. In a non-standard communication after filing the Amended Complaint (and after the Response), the Complainant mentions that the Trademark was originally registered January 2, 1996 under a different owner but did not establish continuity of ownership or business succession between the different trademark owners.

The disputed domain name <liquidaudio.com> was registered January 2, 1996 and currently resolves to a registrar suspended website due to these proceedings. Prior to the suspension, the Complainant claims that the website was actively used providing Amazon affiliate links, without submitting any relevant proof.

The Respondent has filed an administratively compliant response and is claiming registration rights of the disputed domain name

prior to the trademark registration date.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that the disputed domain name is identical to the Trademark.

Furthermore, the Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. In this regard, the Complainant states that the Respondent is not commonly known by the Trademark, is not affiliated with nor authorized by the Complainant in any way, that neither license nor authorization has been granted to the Respondent to make any use of the Trademark or apply for registration of the disputed domain name and that the disputed domain name's use in not a legitimate non-commercial or fair use.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. It contends that the Respondent registered the disputed domain name in order to hold the domain name without using it with a website, engaging in a pattern of conduct by registering domain names in order to prevent trademark owners from reflecting their trademarks in corresponding domain names. Further, Complainant contends that the Respondent is using the disputed domain name in bad faith for the purpose of disrupting the Complainant’s business and intentionally attempting to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the Trademark as to the source, sponsorship, affiliation, or endorsement.

RESPONDENT:

The Respondent contends that he is the registrant of the disputed domain name, that the disputed domain name has been registered since 1996 and that the business of the Complainant is much younger. He is also willing to make an offer and that there have been attempts to agree on a "small compensation" for the disputed domain name but the Complainant did not react.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown that the Respondent has no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has failed to show that the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

Under paragraph 4(a) of the Policy, the Complainant must prove that each of the following three elements is present:

(i) the disputed domain name is identical or confusingly similar to the Complainant's trademark; and

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

1. The Panel accepts that the disputed domain name is identical to the Trademark as it fully incorporates it.

2. The Complainant has substantiated that the Respondent has no rights or legitimate interests in the disputed domain name. The Panel finds that the Complainant has fulfilled its obligations under paragraph 4(a)(ii) of the Policy. The Respondent did not explicitly deny these assertions and did not go into details in order to rebut Complainant's arguments and therefore failed to meet his burden of proof and prove any rights or legitimate interests in the disputed domain name.

3. With respect to the third element of the Policy and in line with the arguments presented by the Parties, it is clear that there can be 3 different scenarios that require a decision by the Panel:

i) The Complainant is the owner of the Trademark, registered since 2024 but with prior first use since 2022:

The disputed domain name is registered since 1996 and even if there has been an update or a nameserver change in April 2023, as the Complainant is arguing, the latter failed to prove that the domain name changed holders and that the Respondent became the Registrant only in April 2023. Consequently, the date of registration of the disputed domain name predate the date of registration or first use of the Trademark.

ii) The Complainant has used "Liquid Audio" as a common law / unregistered trademark at least since August 2008:

The Complainant has tried to argue that it has common law rights on the name "Liquid Audio" since the establishment of its company Liquid Audio Inc. in 2008.

To establish unregistered or common law trademark rights for the purposes of the UDRP, the Complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant’s goods and/or services. Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys. Specific evidence supporting assertions of acquired distinctiveness should be included in the Complaint (see WIPO Jurisprudential Overview 3.0, Section 1.3).

The Complainant has failed to meet the above threshold and to establish common law or unregistered trademark rights. In any case, the Complainant failed to prove that the Respondent was not the domain name registrant since 1996 and therefore there is no meaning in establishing common law trademark rights in this regard.

iii) The Trademark has been registered since 1996, however, the Complainant failed to establish a connection with the previous trademark owner.

The Complainant tried to argue that the Trademark was originally registered since 1996 but did not make any effort and did not provide any proof why this should be relevant for the proceedings, since there has been no established connection between the previous trademark owner with the Complainant. Consequently, the Complainant failed to show prior rights vis-à-vis a trademark.

In light of the above, the Panel cannot find a registration in bad faith. The Complainant failed to establish and prove a broken chain of possession with respect to the disputed domain name and therefore has failed to fulfill its obligations under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **liquidaudio.com**: Remaining with the Respondent

PANELLISTS

Name	**Stefanie Efstathiou LL.M. mult.**

DATE OF PANEL DECISION 2024-12-02

Publish the Decision